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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,483	09/19/2003	Manuel Becerra	006128/260159	4368

826 7590 03/23/2006

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EXAMINER

COBANOGU, DILEK B

ART UNIT PAPER NUMBER

3626

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/664,483

Applicant(s)

BECERRA ET AL.

Examiner

Dilek B. Cobanoglu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/21/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-30 have been examined.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 1 comprises a method of providing insurance to a customer and it's not clear how the method step provides insurance coverage that protects said customer against damage or other loss to said item in response to said customer purchasing said service contract.

- b. Claims 2-9 are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite according to the dependency on claim 1.

- c. Claim 10 is comprises a method of processing a request that an item be repaired or replaced said method comprising determining whether said item requires replacement or repair due to: (1) an event covered under a service contract provided by a first provider, or (2) an event covered under an insurance policy provided by a second provider, and it's not clear how this is done according to the claim.

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- d. Claims 11-16 are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite according to the dependency on claim 10.
  - e. Claim 17 comprises a property protection program comprises first property coverage that is paid for by a first entity; and second property coverage that is paid for by a second entity. Claim 17 is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - f. Claims 18-30 are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite according to the dependency on claim 17.
4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: evaluating or reviewing the service contract and how to provide the insurance coverage.
5. Claims 27 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite and unclear. Claim 27 comprises the property protection program of claim 17, and claim 29 comprises the product protection program of claim 27, wherein said property protection program provides that: (1) in response to said second entity failing to submit timely payment for said second property coverage, said second property coverage will be interrupted; and (2) said first property coverage will not be interrupted in response to said second customer failing to submit timely payment for said second property coverage.

The time interval of the "timely payment" is not clear in these claims. Also, according to the specifications, the first entity is the customer who purchases the product and also the service program, and second entity is the retailer who sells the product and service. In these claims, it's not clear what the Applicant means by "second customer"; is it another customer or the retailer.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1 and 17 are rejected under 35 U.S.C. 101. The claimed invention is directed to non-statutory subject matter. For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

a. Claim 1 comprises; selling a service contract and in response, provide an insurance coverage. This claim does not produce a useful, concrete, and tangible result.

b. Claim 17 comprises; first property coverage that is paid for by a first entity and second property coverage that is paid for by a second entity. This claim does not produce a useful, concrete, and tangible result.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-25 and 27-30 are rejected under 35 U.S.C. 102(e) as being unpatentable by Becker et al. (U.S. Publication No. 2002/0165741 A1).

A. As per claim 1, Becker et al. discloses a method of providing insurance to a customer, said method comprising the steps of:

- i. selling a service contract to said customer, said service contract providing protection against the mechanical breakdown or other failure of an item (Becker et al.; par. 0013); and
- ii. in response to said customer purchasing said service contract, providing, at no cost to said customer, insurance coverage that protects said customer against damage or other loss to said item (Becker et al.; par. 0013).

B. As per claim 2, Becker et al. discloses the method of claim 1, wherein said service contract provides protection against accidental damage to said item (Becker et al.; par. 0008).

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C. As per claim 3, Becker et al. discloses the method of claim 1, wherein said step of providing said insurance coverage is done in order to permit the provision of said insurance coverage without its sale by an insurance agent (Becker et al.; par. 0014).

D. As per claim 4, Becker et al. discloses the method of claim 1, wherein said insurance coverage is paid for by a retailer selling said item to said customer (Becker et al.; par. 0015).

E. As per claim 5, Becker et al. discloses the method of claim 1, wherein said insurance coverage is paid for by a manufacturer of said item (Becker et al.; par. 0015).

F. As per claim 6, Becker et al. discloses the method of claim 1, wherein said insurance coverage is paid for by a service provider that provides service or functionality for said item (Becker et al.; par. 0015).

G. As per claim 7, Becker et al. discloses the method of claim 1, further comprising the step of providing said service contract and said insurance coverage to said customer within a product protection program (Becker et al.; par. 0016).

H. As per claim 8, Becker et al. discloses the method of claim 7, wherein said product protection program is referred to by a single identification indicia (Becker et al.; par. 0008 and 0013).

Examiner considers that since there is a bundled registration and loss protection service and a database that can be registered the customer and

updated by the customer and/or retailer, there is a single identification indicia in the Becker et al. art.

I. As per claim 9, Becker et al. discloses the method of claim 1, wherein said service contract is provided by a first provider and said insurance coverage is provided by a second provider, said first and second providers being different entities (Becker et al.; par. 0018).

J. As per claim 10, Becker et al. discloses a method of processing a request that an item be repaired or replaced, said method comprising:

- i. receiving said request at a central claim processing facility (Becker et al.; par. 0018);
- ii. determining whether said item requires replacement or repair due to: (1) an event covered under a service contract provided by a first provider, or (2) an event covered under an insurance policy provided by a second provider (Becker et al.; par. 0018);
- iii. in response to determining that said item requires replacement or repair due to an event under said service contract, submitting a request to said first provider to process said item according to said service contract (Becker et al.; par. 0019); and
- iv. in response to determining that said item requires replacement or repair due to loss under said insurance policy, submitting a request to said second provider to process said item according to said insurance policy (Becker et al.; par. 0020).



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K. As per claim 11, Becker et al. discloses the method of claim 10, further comprising the step of processing an insurance claim corresponding to said request that said item be repaired or replaced (Becker et al.; par. 0018).

L. As per claim 12, Becker et al. discloses the method of claim 10, wherein an individual associated with said central claim processing facility executes said step of determining whether said item requires replacement or repair due to: (1) an event covered under said service contract; or (2) an event covered under said insurance policy (Becker et al.; par. 0018 and 0019).

M. As per claim 13, Becker et al. discloses the method of claim 10, wherein said step of submitting a request to said first provider is executed by an individual associated with said central claim processing facility (Becker et al.; 0019).

N. As per claim 14, Becker et al. discloses the method of claim 10, wherein said step of submitting a request to said second provider is executed by an individual associated with said central claim processing facility (Becker et al.; 0019).

O. As per claim 15, Becker et al. discloses the method of claim 10, wherein an individual associated with said central claim processing facility executes said steps of: determining whether said item requires replacement or repair due to: (1) an event covered under said service contract, or (2) an event covered under said insurance policy; and submitting a request to said first provider (Becker et al.; 0018 and 0019).

P. As per claim 16, Becker et al. discloses the method of claim 10, wherein an individual associated with said central claim processing facility executes said

steps of: determining whether said item requires replacement or repair due to: (1) an event covered under said service contract, or (2) an event covered under said insurance policy; and submitting a request to said second provider (Becker et al.; 0018 and 0019).

Q. As per claim 17, Becker et al. discloses a property protection program comprising: first property coverage that is paid for by a first entity; and second property coverage that is paid for by a second entity (Becker et al.; 0018).

K. As per claim 18, Becker et al. discloses the property protection program of claim 17, wherein said property protection program is referenced by a single identification indicia (Becker et al.; par. 0008 and 0013).

Examiner considers that since there is a bundled registration and loss protection service and a database that can be registered the customer and updated by the customer and/or retailer, there is a single identification indicia in the Becker et al. art.

R. As per claim 19, Becker et al. discloses the property protection program of claim 17, wherein said first property coverage protects against the mechanical breakdown of one or more items (Becker et al.; 0015).

S. As per claim 20, Becker et al. discloses the property protection program of claim 17, wherein said first property coverage protects against accidental damage to said one or more items (Becker et al.; 0015).

T. As per claim 21, Becker et al. discloses the property protection program of claim 19, wherein said second property coverage protects against a loss other

than accidental damage to said one or more items (Becker et al.; 0017 and 0018).

U. As per claim 22, Becker et al. discloses the personal protection program of claim 19, wherein said second property coverage protects against the accidental damage to, or loss of, said one or more items (Becker et al.; 0017 and 0018).

V. As per claim 23, Becker et al. discloses the property protection program of claim 17, wherein said first entity is a customer who has purchased an item that is covered by said property protection program (Becker et al.; 0018).

W. As per claim 24, Becker et al. discloses the property protection program of claim 23, wherein said second entity is a retailer that has sold said item to said customer (Becker et al.; 0018).

X. As per claim 25, Becker et al. discloses the property protection plan of claim 23, wherein said second entity is a service provider that is to provide service or functionality for said item (Becker et al.; 0018).

Y. As per claim 27, Becker et al. discloses the property protection program of claim 17, wherein said property protection program provides that: (1) in response to said second entity failing to submit timely payment for said second property coverage, said second property coverage will be interrupted; and (2) said first property coverage will not be interrupted in response to said second customer failing to submit timely payment for said second property coverage (Becker et al.; 0015 and 0018).

L. As per claim 28, Becker et al. discloses the property protection plan of claim 27, wherein said product protection program is referenced by a single identification indicia (Becker et al.; par. 0008 and 0013).

Examiner considers that since there is a bundled registration and loss protection service and a database that can be registered the customer and updated by the customer and/or retailer, there is a single identification indicia in the Becker et al. art.

Z. As per claim 29, Becker et al. discloses the property protection program of claim 27, wherein said product protection program provides that: (1) in response to said first customer failing to submit timely payment for said first property coverage, said first property coverage will be interrupted; and (2) said second property coverage will be interrupted in response to said first customer failing to submit timely payment for said first property coverage (Becker et al.; 0015 and 0018).

AA. As per claim 30, Becker et al. discloses the property protection program of claim 29, wherein said product protection program is referenced by a single identification indicia (Becker et al.; par. 0008 and 0013).

Examiner considers that since there is a bundled registration and loss protection service and a database that can be registered the customer and updated by the customer and/or retailer, there is a single identification indicia in the Becker et al. art.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al. (U.S. Publication No. 2002/0165741 A1) in view of Rydbeck (U.S. Patent No. 6,519,470).

A. As per claim 26, Becker et al. discloses the property protection plan of claim 23.

Becker et al. fails to expressly teach the second entity is a wireless carrier that provides wireless service for said item, per se, since it appears that Becker et al. is more directed to provide entities such as sightholder, a wholesaler or dealer and a retailer (Becker et al.; par. 0013 and 0018).

However, this feature is well known in the art, as evidenced by Rydbeck.

In particular, Rydbeck discloses a second entity is a wireless carrier that provides wireless service for said item (Rydbeck; col. 2, lines 21-48).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the entities such as sightholder, a wholesaler or dealer and a retailer with the second entity is a wireless

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carrier that provides wireless service for said item with the motivation of manufacturers of wireless communications devices provide a time limited warranty (Rydbeck; col. 1, lines 15-17).

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not used art teach "Apparatus and method for processing and/or for providing vehicle information and/or vehicle maintenance information" 2002/0016655, "Method and a system for offering for sale of a product" 2002/0038281, "Emergency information notifying system, and apparatus, method and moving object utilizing the emergency information notifying system" 2002/0115423, "Method for producing identification code, and method and system for giving electronic notice service and electronic meter reading service by using the same" 2002/0128857, "System and method for facilitating creation and management of contractual relationships and corresponding contracts" 2002/0165726, "Method and Apparatus for Coordinating Services" 2003/0014295, "Convergent communications system and method with a rule set for authorizing, debiting, settling and recharging a mobile commerce account" 2003/0026404, "Method and apparatus for coordinating services" 6,950,801 B2.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.

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13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DBC

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Art Unit 3626  
03/17/2006

  
C. LUKE GILLIGAN  
PATENT EXAMINER